

Customer No. 32,127
Attorney Docket No. 03-1013

REMARKS

In the final Office Action,¹ claim 63 was objected to because the term "audio stream" lacked antecedent basis; claims 1-8, 12, 13, 23-32, 36-48, 52, 53, 63-72, 76-83, 85, and 86 were rejected under 35 U.S.C. § 102(a) as being unpatentable over Ben-Shachar et al., U.S. Patent Application Publication No. 2003/0169330 ("Ben-Shachar") in view of Dalal et al., U.S. Patent Application Publication No. 2003/0014488 ("Dalal"); claims 16-22 and 56-62 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ben-Shachar in view of U.S. Patent No. 5,440,624 to Schoof II ("Schoof"); claim 84 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Ben-Shachar and Schoof in view of Dalal; claims 9-11, 33-35, 49-51, and 73-75 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Ben-Shachar and Dalal in view of Schoof; and claims 14, 15, 54, and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Ben-Shachar and Dalal in view of Caspi et al., U.S. Patent Application Publication No. 2004/0249884 ("Caspi").

By this Amendment, Applicants have amended claims 23, 63, and 64.

Claims 1-88 are currently pending, of which claims 1, 16, 23, 24, 31, 41, 56, 63, 64, 71, and 81-86 are independent.

As a preliminary matter, Applicants note that the final Office Action did not mention claims 87 and 88, which depend from claims 1 and 15, respectively. Despite

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to certain requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references) is not a concession by Applicants that such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

Customer No. 32,127
Attorney Docket No. 03-1013

this omission, Applicants have made a good faith effort to respond to the final Office Action and place this application in condition for allowance. However, MPEP § 707.07(i) requires that each claim be mentioned in each action. Therefore, if the presently filed amendment does not place the pending claims in condition for allowance, Applicants request that the Examiner issue a complete Office Action in compliance with MPEP § 707.07(i) and reset the time for response.

A. Claims 1-15, 23-55, and 63-88

Applicants respectfully traverse the rejection of claims 1-8, 12, 13, 23-32, 36-48, 52, 53, 63-72, 76-83, 85, and 86 under 35 U.S.C. § 103(a) for at least the reason that Ben-Shachar and Dalal, taken alone or in combination, do not teach or suggest each and every element recited in the claims.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, all the claim limitations must be taught or suggested by the prior art. See M.P.E.P. § 2143.03 (8th ed., rev. 2, May 2004). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, not in applicant's disclosure." M.P.E.P. § 2143 (8th ed., rev. 2, May 2004).

For example, claim 1 recites, among other things, "selectively deleting the stored audio stream data based on a determination that a user has exited the conference call, while the conference call is ongoing."

Customer No. 32,127
Attorney Docket No. 03-1013

The Examiner properly observed that Ben-Shachar fails to teach this element of claim 1 (see final Office Action, page 3) and relied on Dalal as allegedly disclosing the claim elements deficient in Ben-Shachar (see id. (citing Dalal, ¶ 0041)). According to the Examiner, "Dalal selectively deletes a conference based on a determination that the last participant has exited the conference call, while the conference call is ongoing."

See final Office Action, page 25.

Applicants respectfully disagree with the Examiner's characterization of Dalal. As correctly observed by the Examiner, "Dalal deletes a conference *after* all the participants have left." See id. (emphasis added); Dalal, ¶ 0041 ("[T]he SPCC may . . . automatically delete a conference once all the participants have left.") In contrast, claim 1 requires selective deletion of a stored audio stream corresponding to a conference call "while the conference call is ongoing." A conference call cannot be "ongoing," as claimed, if all the participants have left. Thus, Dalal fails to remedy the deficiency of Ben-Shachar and Applicants respectfully request withdrawal of the rejection of claim 1 under 35 U.S.C. § 103(a).

Independent claims 23, 24, 31, 41, 63, 64, 71, 81-83, 85, and 86, although of different scope, each contain elements corresponding to the elements of claim 1 discussed above. Therefore, these claims are allowable for at least reasons similar to those discussed above with respect to claim 1. In addition, claims 2-8, 12, 13, 25-30, 32, 36-40, 42-48, 52, 53, 65-70, 72, 76-80, 87, and 88 depend from and add additional features to each of independent claims 1, 23, 24, 31, 41, 63, 64, and 71. Accordingly, these claims are allowable for at least the reasons set forth above.

Customer No. 32,127
Attorney Docket No. 03-1013

Applicants respectfully traverse the rejection of claims 9-11, 14, 15, 33-35, 49-51, 54, 55, 73-75, and 84 under 35 U.S.C. § 103(a) for at least the reason that Ben-Shachar Dalal, Schoof and Caspi, taken alone or in combination, do not teach or suggest each and every element recited in the claims.

Independent claim 84, although of different scope, contains elements corresponding to the elements of claim 1 discussed above, which are deficient in Ben-Shachar and Dalal. In addition, claims 9-11, 14, 15, 33-35, 49-51, 54, 55, and 73-75 depend from and add additional features to at least one of independent claims 1, 31, 41, and 71, which Applicants submit are allowable for at least the reasons discussed above. The Examiner relied on Schoof in rejecting claims 9-11, 33-35, 49-51, 73-75, and 84 and relied on Caspi in rejecting claims 14, 15, 54, and 55. However, neither Schoof nor Caspi cures the deficiencies of Ben-Shachar and Dalal identified above.

Schoof discloses a method and apparatus for conducting and moderating a networked electronic conference (see Abstract) and is relied on for its disclosure of playback features. See final Office Action, pages 21 (citing Schoof, col. 4). Caspi discloses a system including a server adapted to manage a multimedia conference (see Abstract) and is relied on for its disclosure of recording and playing features. See final Office Action, page 24 (citing Caspi, ¶ 0009). However, neither Schoof nor Caspi disclose the claim element: "selectively deleting the stored audio stream data based on a determination that a user has exited the conference call, while the conference call is ongoing," as recited in claim 1 and similarly recited in claims 31, 41, 71, and 84. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 9-11, 14, 15, 33-35, 49-51, 54, 55, 73-75, and 84 under 35 U.S.C. § 103(a).

Customer No. 32,127
Attorney Docket No. 03-1013

B. Claims 16-22 and 56-62

Applicants respectfully traverse the rejection of claims 1-8, 12, 13, 23-32, 36-48, 52, 53, 63-72, 76-83, 85, and 86 under 35 U.S.C. § 103(a) for at least the reason that Ben-Shachar and Schoof, taken alone or in combination, do not teach or suggest each and every element recited in the claims. For example, claim 16 recites, among other things, "replaying a selected portion of the audio stream, while the conference call is ongoing."

The Examiner properly observed that Ben-Shachar "miserably fails to explain replaying a selected portion of the stored audio stream data." Final Office Action, page 18. According to the Examiner, however, Schoof "discloses this puzzling complicated mystery." Id. (citing Schoof, col. 4). The Examiner also alleged that "it would have improved the convenience of Ben-Shachar by allowing a conference participant to clarify details at anytime during an ongoing conference as stipulated by Ben-Shachar."
Id.

However, Applicants could find no stipulation in Ben-Shachar that allowing a conference participant to clarify details at anytime during an ongoing conference would have improved convenience. On the contrary, Ben-Shachar describes several disadvantages associated with simultaneously handling transcribing and stream routing tasks and describes the temporal separation of such tasks as desirable. See Ben-Shachar, ¶¶ 0006-0011. In particular, the conference recording system described by Ben-Shachar stores conference data in unprocessed form, thereby enabling "all transcription of data into a playable recording to be postponed until after the conference has ended." See ¶ 63 (emphases added). A conference recording system that handles

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Customer No. 32,127
Attorney Docket No. 03-1013

transcription tasks after a conference has ended, as taught by Ben-Shachar, would necessarily preclude, as opposed to allow, clarification of details during an ongoing conference.

Moreover, any suggested combination must not teach away from the cited references. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose); *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references taken in combination teach away since they would produce a "seemingly inoperative device"). Ben-Shachar states that "a need exists for a recording method and system which minimize the processing tasks at a server during data transmission." See Ben-Shachar, ¶ 0011. For example, according to Ben-Shachar, a Multipoint Control Unit (MCU) is able to handle fewer conferences and attendees than if no transcribing were being performed during the conference." See Ben-Shachar, ¶ 0009. Thus, the Examiner's proposed modification of Ben-Shachar would require the MCU to carry out transcription processing tasks during data transmission and would, therefore, render the recording method and system of Ben-Shachar "inoperable for its intended purpose."

Because the combination of Ben-Shachar and Schoof proposed by the Examiner would operate contrary to Ben-Shachar's stated objective of minimizing the processing tasks at a server during data transmission, there would have been no suggestion or motivation to combine Schoof with Ben-Shachar in the manner alleged by the Examiner. Therefore, Ben-Shachar and Schoof, taken alone or in combination, do not teach or

Customer No. 32,127
Attorney Docket No. 03-1013

suggest each and every element recited in the claims and Applicants respectfully request withdrawal of the rejection of claim 16 under 35 U.S.C. § 103(a).

Independent claim 56, although of different scope, contains elements corresponding to the elements of claim 16 discussed above. Therefore, claim 56 is not anticipated by Ben-Shachar for at least reasons similar to those discussed above with respect to claim 16. In addition, claims 17-22 and 57-62 depend from and add additional features to each of independent claims 16 and 56. Accordingly, these claims are allowable for at least the reasons set forth above.

Conclusion

Applicants respectfully request that this amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-88 in condition for allowance. Applicants submit that the proposed amendments of claims 23, 63, and 64 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Customer No. 32,127
Attorney Docket No. 03-1013

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Reply, please charge the fee to our Deposit Account No. 07-2347.

Respectfully submitted,

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CUSTOMER NO. 32127